

REMARKS

This reply is being filed with a request for continued examination, and is in response to the final Office action mailed on December 12, 2007.

Status of claims and amendments

Claim 1-16 remain pending in the application. Claim 17 is cancelled without prejudice.

The amendments to the claims are not intended to narrow the claims by adding or further limiting any limitations, and are not in response to any rejections. The amendments are minor wording clarifications, and do not change the scope of the subject matter as originally claimed.

Rejection under Section 112, second paragraph

It is submitted that the amendments to claims 1, 14 and 16 and cancellation of claim 17 render moot the rejection of claims 1, 14, 16 and 17. The “if” statement that was the subject of the rejection has been removed. Therefore, this rejection should be withdrawn.

Rejection under Section 101

The rejection of all claims under 35 U.S.C. 101 is respectfully traversed. Applicants’ understand that the Office is still applying the Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility (*Interim Guidelines*), 1300 Off. Gaz. Patent and Trademark Office (O.G.) 142 (Nov. 22, 2005). Therefore, their remarks will be directed to those guidelines. However, applicants do not waive any other arguments concerning the erroneous rejection of the claims under Section 101. According to those guidelines:

The claimed invention as a whole must be useful and accomplish a practical application. That is, it must produce a “useful, concrete and tangible result.” *State Street*, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of “real world” value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (*Brenner v. Manson*, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96 (1966)); *In re Fisher*, 421

F.3d 1365, 76 USPQ2d 1225 (Fed. Cir. 2005); *In re Ziegler*, 992 F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)).

The examiner has not met his burden of establishing a *prima facie* rejection by explaining how the result the result of the claimed subject matter is not tangible, concrete and useful. Rather, the rejection is accompanied by a mere conclusion and requirement that the claims recite a transfer of funds. The claimed subject matter produces a result -- a determination of eligibility for transferring funds between two accounts -- that is tangible, concrete and useful.

Regarding the “tangible” requirement, the *Interim Guidelines* explain:

The tangible requirement does not necessarily mean that a claim must either be tied to a particular machine or apparatus or must operate to change articles or materials to a different state or thing. However, the tangible requirement does require that the claim must recite more than a § 101 judicial exception, in that the process claim must set forth a practical application of that § 101 judicial exception to produce a real-world result. *Benson*, 409 U.S. at 71-72, 175 USPQ at 676-77 (invention ineligible because had “no substantial practical application.”).

It is submitted that no showing has been made that the result is not “real world.” It is, in fact, very much real world. The result includes a decision on whether to transfer funds between accounts.

Turning to the “concrete” requirement, the *Interim Guidelines* teach:

Another consideration is whether the invention produces a “concrete” result. Usually, this question arises when a result cannot be assured. In other words, the process must have a result that can be substantially repeatable or the process must substantially produce the same result again. *In re Swartz*, 232 F.3d 862, 864, 56 USPQ2d 1703, 1704 (Fed. Cir. 2000) (where asserted result produced by the claimed invention is “irreproducible” claim should be rejected under section 101). The opposite of “concrete” is unrepeatable or unpredictable.

Again, there is no showing by the examiner that the result of the claimed subject matter is not unrepeatable or unpredictable. The result produced by the claimed subject is very predictable.

Rejection under Section 102(e)

The examiner continues to contend that US Patent No. 6,267,292 B1 of Walker, et al. (“Walker”) discloses in figure 8A, at step 825, “determining if financial institution (of first credit account) is related to financial institution (of second credit account), and at step 830 in the same figure, “if true – identifying first credit account as being not eligible for a balance transfer to second credit account.” Applicants continue to respectfully disagree.

Step 825 states “Issuing banks loop up credit card information of the transferor and the transferee.” Step 830 states “does incomplete transferor credit information provided match complete information?” Walker concerns generally one credit card holder (the “transferor”) making a payment to another credit card holder (the “transferee”) by debiting his credit card and crediting the transferee’s credit card. Col. 4, lines 23-26. Figure 8A is simply describing the steps of the credit card holder transferor (see col. 7, lines 59-61) providing instructions that include the credit card account information of the respective parties (col. 7, line 61, to col. 8, lines 4), the respective issuing banks looking up the complete credit card information of the respective transferor and transferee (step 825 of Fig. 8A), and validating it (steps 830 and 840 of Fig. 8A). See also Col. 8, lines 5-25.

In order to anticipate a claim, a single, prior art reference must contain each and every element set forth in the claim. Manual for Patent Examination Procedure, § 2131 (8th ed. August, 2006).

Each of the claims 1-17, either expressly or by dependency, requires a determination be made as to whether the financial institution holding the first credit account is related to the financial institution holding the second credit account are related, and processing a balance transfer request if the request meets all of at least one balance transfer eligibility requirement, the at least one eligibility requirement comprising a requirement that the financial institutions holding the respective accounts not be related. Walker makes no mention of these limitations in Figure 8a. The only determination that appears to be made by Walker is whether incomplete information provided by the transferor (e.g. last 6 digits of credit card number) matches complete information and the credit cards are valid. See col. 4, lines 33-36, and col. 8, lines 5-25.

For at least these reasons, Walker cannot anticipate claims 1-17 and, therefore, the rejection is in error.

Remaining Errors in Reasoning

In view of the foregoing errors, remaining errors in the reasoning of the examiner are moot. Applicants' failure to address these errors does not constitute acquiescence or waiver in the examiner's reasoning. Applicants reserve the right to address these errors in later remarks or on appeal, if necessary.

Conclusion

For the reasons given, it is submitted that the application is condition to be allowed, and such action is respectfully requested.

Applicant hereby authorizes the Commissioner to charge any fees due but not submitted with this paper to Deposit Account No. 07-0153. The Examiner is respectfully requested to call Applicant's Attorney for any reason that would advance the current application to issue. Please reference Attorney Docket No. 132538-1016.

Respectfully submitted,

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